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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/870,762	05/31/2001	Garret A. Fitzgerald	53893-5024	1141

7590

09/24/2002

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EXAMINER

GITOMER, RALPH J

ART UNIT

PAPER NUMBER

1627

DATE MAILED: 09/24/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/870,762

Applicant(s)  
Fitzgerald et al.

Examiner  
Ralph Gitomer

Art Unit  
1627



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Jul 22, 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 8-34 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 8-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 8 6) ☐ Other:

The amendment and IDS received 7/22/02 have been entered and claims 1-5, 8-34 are currently pending in this application.

In view of the amendments to the claims and arguments  
5 presented, the rejections of record under 35 USC 102(a or b),  
103(a), and 112, second paragraph are hereby withdrawn.

Claims 1-5, 8-34 are rejected under 35 U.S.C. 112, first  
10 paragraph, as containing subject matter which was not described  
in the specification in such a way as to enable one skilled in  
the art to which it pertains, or with which it is most nearly  
connected, to make and/or use the invention.

The claims are directed to identifying compounds for  
treating AD and their posology, treating disorders that raise the  
15 level of isoprostane markers, and kits.

The specification as originally filed does not provide  
written description of any compounds found for effectively  
treating AD nor their posology. Further, no other treatments for  
isoprostane elevating disorders are shown. And no kits are seen.

Applicant's arguments filed 7/22/02 have been fully considered but they are not persuasive.

Applicants argue that Applicant does not need to have actually reduced the invention to practice to enable the invention. The artisan would be able to perform the methods of the claims with the specification as filed without undue experimentation. One routinely screens compounds for treating diseases.

It is the examiner's position that claims directed to diagnosing AD, identifying compounds for treating AD and their posology, treating disorders that raise the level of isoprostane markers and kits are not taught by the specification as originally filed sufficiently for one of skill in this art to effectively use the claimed inventions. Much more than routine experimentation would be required to make and use the claimed invention. Screening for drugs is not new but how to screen specifically with success in finding an effective treatment for AD is not routine.

The above claimed methods and kits are not enabled because the applicants were not in possession of the methods to perform their stated functions as claimed at the time the invention was made. Further, the specification does not include a teaching of how to make and use the claimed processes for their stated functions. There is only speculation and conjecture set forth in the specification regarding the processes but no specifics or

examples of how to perform the claimed processes, i.e. it would require undue experimentation to determine precisely how to perform the claimed methods effectively.

5           Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

10           A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened  
15           statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the  
20           statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ralph Gitomer whose telephone number is (703) 308-0732. The examiner can normally be reached on Tuesday-Friday from 8:00 am - 5:00 pm.

5 The examiner can also be reached on alternate Mondays. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane can be reached on (703) 308-4537. The fax phone number for this Art Unit is (703) 308-4556.

10 Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1235. For 24 hour access to patent application information 7 days per week, or for filing applications electronically, please visit our website at [www.uspto.gov](http://www.uspto.gov) and click on the button Patent Electronic Business

15 Center for more information.



Ralph Gitomer  
Primary Examiner  
Group 1627